

## REMARKS

Claims 1-15 are pending in this patent application. By this amendment, claims 14-15 have been canceled, and claims 1-13 have been amended. Reconsideration of this patent application, as amended, is respectfully requested.

### Allowable Claim 12

Claim 12 was indicated as being allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. However, claim 12 has not been so amended since Applicants believe the claim from which claim 12 depends is itself allowable.

### Objection to Drawings

The drawings were objected to since it appears that the Examiner believes the following features are not currently shown in the drawings:

#### First Feature

"the guide block including connector shafts which extend from the fixation part of the guide part" (claim 4)

#### Second Feature

"the drive including at least one threaded shaft on one of the fixation part or the guide part and a threaded bore on the other part" (claim 10)

#### Third Feature

"the guide block further includes a flexible drive shaft which can be connected to the guide block" (claim 13)

#### Fourth Feature

"the guide block further including at least one position indicator" (claim 14).

Newly added figure 3 depicts the first, second, and third features identified above (see, e.g., the threaded connector shafts 23, the threaded bores 21, and the

flexible drive shafts 19). Support for the features shown in newly added figure 3 can be found, among other places, at page 7, lines 5-9 of the specification text. The fourth feature identified above is currently shown in Fig. 2 (see, e.g., the three position indicators 30).

### **First 35 U.S.C. § 112 Rejection**

Claim 13 was rejected under 35 U.S.C. § 112, first paragraph. In particular, it was stated that the examiner does not understand how a flexible drive shaft would be connected to the guide block and cause a relative rotation between the threaded shaft and the threaded bore. In order to facilitate the Examiner in his understanding of this feature, the patent application text at page 7, second paragraph has been amended to include the word "move", such that the paragraph now reads "... flexible drive shafts which are connected to *move* the guide part of the guide block." This correction finds support in the following sentence of the same paragraph which describes a hexagonal male part being received in a hexagonal socket on the fixation part of the guide block. Without the correction the two sentences are somewhat contradictory, the first one clearly not being consistent with the overall teaching of the specification.

With this correction, the second paragraph of page 7 of the specification text clearly describes an apparatus for connecting a flexible drive shaft to the fixation part for the purpose of moving the guide part, the flexible drive shaft being remotely operable either manually or with a motor. It is submitted that

such flexible drive shafts are commonly known and would comprise part of the common general knowledge for one of ordinary skill in the art.

The relative rotation between the threaded shaft and the threaded bore as a result of this connection can clearly be ascertained from the third paragraph on page 7 of the specification text as filed. Here the specification teaches the motors being connected directly to the fixation part to control the movement of the guide part relative to the fixation part, instead of the knobs as previously described. It is clear from the specification text the knobs are connected to the threaded shafts from paragraph three of page four in the specification text as filed. Hence, one of ordinary skill in the art, when taking the specification as a whole, would be quite clear that the connection of the flexible shaft to the fixation part relates to a connection to the threaded shaft and threaded bore and would be fully enabled to make and use the present invention.

### **Second 35 U.S.C. § 112 Rejection**

Claims 10-13 were rejected under 35 U.S.C. § 112, second paragraph, due to various antecedent basis issues. Each of claims 10-13 has been amended to provide proper antecedent basis for the claim terms used therein.

### **First 35 U.S.C. § 102 Rejection**

Claims 1, 3-9, and 14 were rejected under 35 U.S.C. § 102 as being anticipated by Milliard (U.S. Patent No. 6,712,824). Claim 14 has been canceled. In addition, claims 1 and 3-9 have been amended to more clearly define the

invention. Reconsideration of claims 1 and 3-9, as amended, is respectfully requested.

#### *Amended Claim 1*

Claim 1, as amended, recites the following limitation:

a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part to a desired position relative to the reference point.

Among other things, Milliard does not disclose that its positioning apparatus P includes *a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part ...* as called for in amended claim 1. Since Milliard does not disclose this claim limitation of amended claim 1, Milliard does not anticipate amended claim 1.

#### *Amended Claims 3-9*

Each of claims 3-9 depends directly or indirectly from amended claim 1. As a result, each of claims 3-9 is allowable for, at least, the reasons hereinbefore discussed with regard to amended claim 1.

#### **Second 35 U.S.C. § 102 Rejection**

Claims 1, 2, 4-6, 8-11, and 13 were rejected under 35 U.S.C. § 102 as being anticipated by Pohl (U.S. Patent No. 4,703,751). Each of claims 1, 2, 4-6, 8-11, and 13 have been amended to more clearly define the invention.

Reconsideration of claims 1, 2, 4-6, 8-11, and 13, as amended, is respectfully requested.

*Amended Claim 1*

As stated above, amended claim 1 recites the following limitation:

a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part to a desired position relative to the reference point.

Among other things, Pohl does not disclose that its resection apparatus 10 includes *a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part ...* as called for in amended claim 1. Since Pohl does not disclose this claim limitation of amended claim 1, Pohl does not anticipate amended claim 1.

*Amended Claims 2, 4-6, 8-11, and 13*

Each of claims 2, 4-6, 8-11, and 13 depends directly or indirectly from amended claim 1. As a result, each of claims 2, 4-6, 8-11, and 13 is allowable for, at least, the reasons hereinbefore discussed with regard to amended claim 1.

**Third 35 U.S.C. § 102 Rejection**

Claims 1, 2, and 4-8 were rejected under 35 U.S.C. § 102 as being anticipated by Lackey (U.S. Patent No. 5,108,396). Each of claims 1, 2, and 4-8

has been amended to more clearly define the invention. Reconsideration of claims 1, 2, and 4-8, as amended, is respectfully requested.

#### *Amended Claim 1*

As stated above, amended claim 1 recites the following limitation:

a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part to a desired position relative to the reference point.

Among other things, Lackey does not disclose that its humeral resection guide 100 includes *a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part ...* as called for in amended claim 1. Since Lackey does not disclose this claim limitation of amended claim 1, Lackey does not anticipate amended claim 1.

#### *Amended Claims 2 and 4-8*

Each of claims 2 and 4-8 depends directly or indirectly from amended claim 1. As a result, each of claims 2 and 4-8 is allowable for, at least, the reasons hereinbefore discussed with regard to amended claim 1.

#### **35 U.S.C. § 103 Rejection**

Claim 15 was rejected under 35 U.S.C. § 103 as being unpatentable over Milliard (U.S. Patent No. 6,,712,824) in view of Couture (U.S. Pat App Pub. No. 2004/0039396). Claim 15 has been canceled. Thus, this rejection is moot.

## **Amended Claim 1 is Not Unpatentable Over a Combination of Milliard and Couture**

Claim 1 was amended to incorporate much of the language of now canceled claims 14 and 15. Since canceled claim 15 was rejected under 35 U.S.C. § 103 as being unpatentable over Milliard (U.S. Patent No. 6,,712,824) in view of Couture (U.S. Pat App Pub. No. 2004/0039396), a discussion of the patentability of amended claim 1 over these patent references is appropriate.

### ***Amended Claim 1***

As stated above, amended claim 1 recites the following limitation:

a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part to a desired position relative to the reference point.

As discussed previously, Milliard does not disclose *a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part ...* as called for in amended claim 1.

Couture discloses a computer assisted surgical (CAS) system for tracking a universal positioning block. Paragraph [0036] of Couture discloses that the CAS system provides means for determining the position, orientation, and movement of the universal positioning block in three dimensions, and permits the positioning block to be visualized relative to the patient anatomy. However, while Couture's CAS system may generate signals indicative of the position,

orientation, and movement of the universal positioning block during an operation, the CAS system does not include a signal generator that is connected to the drives, and the CAS system cannot transmit any position signals to the drives to cause the guide part to be moved relative to the fixation part as called for in amended claim 1. It appears that the device of Couture relies on the surgeon to manually make the adjustments to the relevant components of the universal positioning block. (See, e.g., Couture at paragraph [0043] and Figure 12, step 205.) Thus, Couture does not disclose *a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part ... as called for in claim 1*. Further, there is no teaching in Couture as to how to move the drives (e.g. via a powered drive) based on any signal that would be generated.

Since neither Milliard nor Couture disclose "a signal generator which is connected to the drives for generating position signals which can be transmitted to the drives to cause the guide part to be moved relative to the fixation part ... ", then a combination of Milliard and Couture cannot arrive at a system that includes such claimed feature. Accordingly, the proposed combination of Milliard and Couture does not arrive at the invention of amended claim 1. Thus, the proposed combination does not establish a prima facie case of obviousness under 35 U.S.C. § 103 with regard to the invention defined in amended claim 1. As a result, amended claim 1 is allowable over Milliard and Couture.

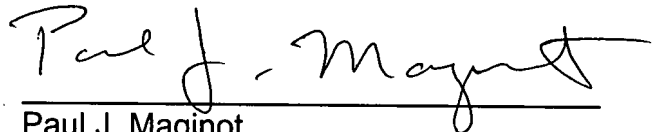


## Conclusion

In view of the foregoing amendments and remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited. It is respectfully submitted that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response, and any deficiency in fees be charged, or any overpayment in fees be credited, to our Deposit Account No. 13-0014.

Respectfully submitted,

MAGINOT, MOORE & BECK LLP

A handwritten signature in cursive script, reading "Paul J. Maginot", written over a horizontal line.

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